REMARKS/ARGUMENTS

This is in response to the office action dated June 12, 2003. Claims 2-5, 8, 9, 12 and 17-19 are pending in the application. Claims 2, 12 and 17-19 are rejected. Claims 3-5, 8 and 9 are objected to.

The present application is a divisional of application Serial No. 09/626,856 which was filed on July 27, 2000. The present application was filed on February 7, 2002. The Examiner has indicated that the Preliminary Amendment filed on the same day as the instant application needs to be referred to in the Declaration. Applicants submitted a transmittal letter with the Divisional application which makes reference to the Preliminary Amendment filed on February 7, 2002. A copy of the Declaration filed in the parent application was also submitted with the Divisional application. It is submitted that a new Declaration referencing the Preliminary Amendment is not required when filing a divisional application.

Claims 2, 12 and 17-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. The Examiner has requested clarification of the recital of the variables "p" and "q" in claim 2. The variable "p" refers to the substituent (R_4) on the sulfonamido groups in the definition of "Z". The variable "q" refers to the methylene group in the ∝-aminoC_{4-7} -alkylene group in the definition of "L". These groups were inadventently omitted from claim 2 when the application was filed. By the present amendment claim 2 has been amended to include the basis for the variables "p" and "q". Applicants have also added the definitions for the variables R_3-R_6 which are part of the definition of "L" and "Z". In addition, the phrase "selected from the group consisting of" has been added to the definitions of "L", "R_1" and "R_2". It is believed that all of the amendments are fully supported by the specification and that no new matter has been added to the claims.

Claim 12 is deemed to lack antecedent basis because the recited species lack a substituent corresponding to -$(CH_2)_m$-R_2- which is recited in claim 2. The Examiner has pointed out that, according to claim 2, the group -$(CH_2)_m$-R_2- is always present since "m" has a value of at least 1 and R_2 can be hydrogen. By the present amendment claim 2 has been amended to define "m" as equal to 0-3. The claims as amended form a basis for claim 12. Support for the amendment is found on page 7 of the specification.

Claims 18 and 19 are deemed to be "substantial duplicates because they both recite a pharmaceutrical composition with different intended uses. The Examiner has concluded that intended uses in a composition claim do not have patentable weight. It is submitted that claim 19 is dependent upon claim 18 and merely clarifies the type of disorder or disease state referred to in claim 18. No particular patentable weight is given to the intended use in and of itself. Applicants wish to point out that claims of similiar scope were found patentable in U.S. patent No. 6,380,224 B1 (see claims 8 and 9; copy enclosed).

Claims 17-19 were rejected as being dependent on a rejected claim 2. It is believed that the amendments to claim 2 have overcome the Examiner's rejection of claim 2.

Reconsideration of the rejection of claims 2, 12 and 17-19 as being indefinite under 35 U.S.C. 112, second paragraph, is courteously requested.

Claims 2 and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Islam *et al.* (WO97/19682.). The Examiner has pointed out that on page 43, line 5, of Islam *et al.* a compound is disclosed which is encompassed by applicants' generic claim. The reference compound is an hydroxy derivative. The claims in the present application have been amended by deleting the hydroxy (OH) substituent from the definition of R_2 in claim 2. It is believed that the claim as amended no longer reads on the reference compound.

Reconsideration of the rejection of claims 2 and 17-19 as being anticipated by Islam *et al.* (WO97/19682.) under 35 U.S.C. 102(b) is courteously requested.

Claims 2 and 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Dax *et al.* (US 6,201,025). The Examiner has referred specifically to compound #28 in Table 1, columns 33 and 34 of the patent and has concluded that the compound is encompassed by applicants' generic claim. In the reference compound "L" is C_{1-2} alkylene. By the present amendment claim 2 has been amended by limiting the definition of "L" to (N-methylene)piperazin-4-yl and (N-methylene)-4-acetyl-piperidin-4yl when "Z" is aryl or heteroaryl. It is believed that the claim as amended does not read on the reference compound.

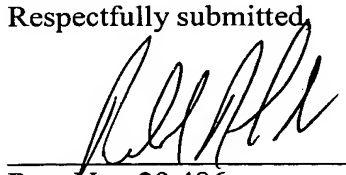
Claims 2 and 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Dax *et al.* (US 6,140,354). The Examiner has referred specifically to compounds #52 and #57 in the table in columns 71 and 72 of the patent and has concluded that the reference compounds are encompassed by applicants' generic claim. In the reference compounds "L" is C_6 cycloalkylene. By the present amendment claim 2 has been amended by limiting the definition of "L" to α-aminoC_{4-7}alkylene, (N-methylene)piperidin-4-yl and (N-methylene)pyrrolidin-3-yl when "Z" is N-sulfonamido or N(aryl)sulfonamido. It is believed that the claim as amended does not read on the reference compounds.

Reconsideration of the rejection of claims 2 and 17-19 as being anticipated by Dax *et al.* (US 6,140,354) under 35 U.S.C. 102(e) is courteously requested.

Claims 3-5, 8 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In view of the amendments made to base claim 2, it is believed that the claims as amended are now allowable. No need is seen, therefore, to rewrite claims 3-5, 8 and 9 in independent form.

In view of the above discussion and the amendments herein being made to the claims, it is believed that all of the outstanding objections and rejections have been removed. Applicants respectfully request that a timely Notice of Allowance be issued in this application.

Respectfully submitted,



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(2S)-2-(Acetylamino)-6-[(2-fluorophenylsulfonyl) amino]-N-[cis-1,2,3,4-tetrahydro-6-hydroxy-1-(3-pyridinylmethyl)-2-naphthenyl]hexanamide bis-hydrochloride,

3-[(Phenylsulfonyl)amino]-N-[cis-1,2,3,4-tetrahydro-6-fluoro-1-(3-pyridinylmethyl)-2-naphthalenyl]-1-pyrrolidineacetamide bis-trifluoroacetate,

4-Oxo-1-phenyl-N-[cis-1,2,3,4-tetrahydro-1-(3-pyridinylmethyl)-2-naphthalenyl]-1,3,8-triazaspiro [4.5]decane-8-acetamide bis-hydrochloride,

trans-N-[2-(4-fluorophenyl)-3-(3-pyridinyl)propyl]-4-[((2-fluorophenylsulfonyl)amino)methyl]-1-cyclohexanamide hydrochloride,

trans-N-[[[[[2-(4-fluorophenyl)-3-(3-pyridinyl)propyl] amino]methyl]-4-cyclohexyl]methyl] 2-fluorobenzenesulfonamide bis-hydrochloride.

7. A method of treating disorders and diseases associated with NPY receptor subtype 5 comprising administering to a mammal in need of such treatment a therapeutically effective amount of a compound of claim 1.

8. A pharmaceutical composition for the treatment of diseases or disorders associated with the NPY Y5 receptor subtype comprising a therapeutically effective amount of a compound of claim 1 and a pharmaceutically acceptable carrier.

9. A pharmaceutical composition according to claim 8 for the treatment of disorders or disease states caused by eating disorders, obesity, bulimia nervosa, diabetes, memory loss, epileptic seizures, migraine, sleep disturbances, pain, sexual/reproductive disorders, depression and anxiety.

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